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09/835,779	04/16/2001	Terry L. Long	2127/5/00	9467

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EXAMINER

MADSEN, ROBERT A

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 12/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/835,779

### Applicant(s)

LONG, TERRY L.

### Examiner

Robert Madsen

### Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. The amendment filed August 15, 2003 has been entered. Claims 1-15,19-21 remain pending in the application, and claims 15,19-21 were withdrawn by applicant, and claims 16 and 17 were cancelled.
2. The rejection of claims 7-9 made under 35 U.S.C. 103(a) as being unpatentable over Kurz (US 2027596), Hilton et al. (US 4052838), Fairbank (US 2555585), and Birdseye (US 1852228) stands and have been copied into this office action.
3. The rejection of claim 10,11, and 13 made under 35 U.S.C. 102(b) as being anticipated Lamb (US Re26796) stands and has been copied into this office action.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 1-6 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims 1 and 4 contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
6. On page 14 of the specification applicant discloses:

This close stacking mutual support assembly 30 can then be enclosed in a container suitable for shipping or storage. The container chosen may be a carton of suitable dimension, a plastic bag, or a carton lined with a plastic liner or a plastic bag.

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7. Claim 1 recites a "non-box flexible storage container" for eliminating boxing of the cut uncooked potatoes in storage cartons. With respect to the particular container limitation recited, this would include containers outside of the containers disclosed (e.g. a thin walled plastic tray with a film cover or an aluminum pouch). Furthermore, applicant has not disclosed a method *for eliminating* boxing in storage cartons. In fact, this limitation appears to contradict the disclosure since applicant discloses that three of the four suggested containers include cartons. Only one of the disclosed containers is a non-box flexible containers (i.e. plastic bag), and applicant's disclosed method of cutting and arranging potatoes is not "for eliminating boxing". Thus, there is no support for these limitations in claim 1, and for examination purposes the container will be limited to plastic bags.

8. Claim 4 recites a "non-box" shipping container. This limitation may include plastic trays with film covers, aluminum pouches, aluminum cans and cardboard based canisters, all of which are not disclosed. Thus, there is no support in the specification for the broad limitation of non-box container, and for examination purposes the non-box containers will be limited to plastic bags.

9. Claim 18 recites a "flexible plastic container". This limitation may include plastic trays with film covers, which is not disclosed. Thus, there is no support in the specification for the broad limitation "flexible plastic container", and for examination purposes this limitation is limited to a plastic bag.

***Claim Rejections - 35 USC § 102***

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 10, 11, 13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kurz (US 2027596). See Figures, Column 1, line 40 to Column 2, line 42. Note that the Kurz teaches a stackable brick of "uncooked solid parts" *prior* to filling and frying.

12. Claims 10, 11, 13, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lamb (US Re26796). See Figure 1, Column 1, lines 30-50, Column 3, line 60 to Column 4, line 22, Column 5, lines 8-17, 42-54, Column 5, line 65 to Column 6, line 5, and Column 12, lines 50-62.

***Claim Rejections - 35 USC § 103***

13. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

14. Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Catalina (US 3680615) in view of Kurz (US 2027596) in view of Croft (US 6074677).

15. Regarding claims 1, 2, 4, and 5, Catalina teaches forming uniformly shaped rectangular potatoes that are initially arranged in side by side arrays, stacked as a result of coring, and that are to be packaged (See Figures in light of Column 1, lines 60-65, Column 2, lines 36-58). Catalina also teaches it is well known to freeze pre-cut

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uncooked potatoes slices (e.g. French fries) in bags for subsequent frying by the consumer (Column 1, lines 8-20). However, Catalina is silent in teaching packaging the potato slices in a stacked, side-by side configuration to minimize breakage. Catalina is also silent in teaching *plastic* bags.

16. Kurz teaches uniform rectilinear potato shapes stacked in a side-by side configuration closed together after being fried, bored, and filled (i.e. jelly) can endure handling and packaging without undue loss (See Figures, Column 1, line 40 to Column 2, line 42 Column 3, line 33-40).

17. Examiner takes official notice that fried potato slices have softer interior textures than “uncooked” potato slices (e.g. such as those taught by Catalina). As such, fried potato slices filled with jelly (e.g. Kurz) would have been even softer than fried potato slices. Therefore, it would have been obvious to modify Catalina and stack the uniformly rectangular cut potato pieces in a side-by-side configuration as taught by Kurz since this would allow an uncooked potato slice to endure handling and packaging without undue loss because Kurz teaches such a configuration provides the same benefit for more fragile fried and jelly filled potato pieces.

18. With respect to plastic bags, once it was known to package uncooked potato slices in bags for freezing, to utilize any conventional bag material, such as plastic, would have been an obvious matter of choice depending on the desired storage properties (e.g. a plastic bag would provide an extended storage time over a paper bag).

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19. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Catalina (US 3680615) in view of Kurz (US 2027596), as applied to claims 1,2,4 and 5 further in view of Hilton et al. (US 4052838).

20. Catalina is silent in teaching purging air and filling with an inert gas.

21. Hilton et al. teach it is notoriously well known in the art that a benefit of forming uniformly shaped potato products is the products may be packaged in relatively small packages that are more or less air tight, in an inert atmosphere to improve the shelf-life. (Column 1, lines 10-55). Therefore, it would have been obvious to modify Catalina and purge air from the bag and fill the bag with an inert gas since this would improve the shelf life of the potatoes.

22. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurz (US 2027596) in view of Hilton et al. (US 4052838) and Fairbank (US 2555585) and Birdseye (US 1852228).

23. Kurz teaches cutting potatoes into uniform rectilinear shapes that are stacked close together and can endure handling and packaging without undue loss. Kurz is silent in teaching the packaging minimizes the effects of air and minimizes the space required as recited in claim 7, purging the air with an inert gas as recited in claim 8, or freezing the contents of the package as recited in claim 9 (See Figures, Column 1, line 40 to Column 2, line 42 Column 3, line 33-40).

24. Hilton et al. teach it is notoriously well known in the art that a benefit of forming uniformly shaped potato products is the products may be packaged in relatively small

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packages that are more or less air tight, in an inert atmosphere to improve the shelf-life. (Column 1, lines 10-55). Fairbank teaches uniformly rectangular food pieces have the advantage that the food can be packaged in a way to minimize the space required and minimize the exposure to air during storage (Column 1, lines 1-41, Column 4, lines 6-17). Birdseye also teaches minimizing packaging air space for vegetables to enhance the durability of the packaged vegetables and further teaches freezing for storage (Page 1, lines 1-56, Page 2, lines 25-44).

25. Therefore it would have been obvious to modify the Kurz packaging to minimize the effects of air and minimize the space required, as recited in claim 7, as well as to flush with an inert gas, as recited in claims 8, since it is notoriously well known in the packaging art that uniformly shaped potato products, including rectangular shapes have the advantage of being capable of packaged to minimize space and air exposure, by flushing with an inert gas, to provide a longer shelf life than non-uniform shaped potato products. One would have substituting one type of packaging for another for the same purpose packaging stacked uniformly shaped potato products. It would have been further obvious to freeze the package as recited in claim 9, if one desired, since the package since it was known to freeze a vegetable package with a minimum air space to enhance the durability of the vegetable.

26. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable Kurz (US 2027596) as applied to claims 10, 11, and 13 above.



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27. Although Kurz is silent in teaching any particular type of potato, it would have been obvious to use white potatoes, since it is notoriously well known in the art to use white potatoes as to form fried rectangular potato pieces.

28. Claims 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable Kurz (US 2027596) as applied to claims 10, 11, and 13 above, further in view of Catalina (US 3680615).

29. Kurz teaches the stacked solid uncooked potato slices are made hollow, filled, fried and packaged for shipping and storage, but are silent in teaching the solid uncooked potato slices are frozen or arranged in a plastic bag for shipping and storage. However, Catalina teach it is conventional freeze solid uncooked potato slices in a bag for shipping and storage, wherein after storage the slices are subsequently fried (Column 1, lines 8-20). Therefore, to freeze and package the stack of potato slices of Kurz in a bag prior to frying would have been dependent on the desired sale product (i.e. providing a cooked prepared food or a frozen food for preparation in the home) since Catalina teaches it is conventional freeze solid uncooked potato slices in a bag for shipping and storage, wherein after storage the slices are subsequently fried.

30. With respect to plastic bags, once it was known to package uncooked potato slices in bags for freezing, to utilize any conventional bag material, such as plastic, would have been an obvious matter of choice depending on the desired storage properties (e.g. a plastic bag would provide an extended storage time over a paper bag).

***Response to Arguments***

31. Applicant's arguments with respect to claim 1-6, 14 and 18 have been considered but are moot in view of the new ground(s) of rejection.

32. With respect to claims 7-13 applicant argues that Kurz does not teach *packing uncooked* potatoes. It is noted that "packing uncooked potatoes" is not recited in the rejected claims 7- 13. The claims merely require a stacking arrangement. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

33. In response to applicant's argument that the examiner's conclusion of obviousness in claims 7-9 is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Kurz teaches cutting potatoes into uniform rectilinear shapes that are stacked close together and can endure handling and packaging without undue loss. Hilton, Fairbanks, and Birdseye are relied on as evidence of (1) the art recognized benefits of stacking uniform rectilinear shaped food items as taught by Kurz (e.g. limited exposure to air during storage and minimal packaging) and (2) methods to further enhance the

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storability of a stacked array of uniform rectilinear shaped food items (e.g. store uniformly shaped and stacked potatoes in inert gas or store under freezing conditions).

34. Applicant further argues that Lamb does not teach the stackable brick-shaped arrangement of uncooked solid parts as now recited in claim 10. However, Lamb does teach a "stackable" brick-shaped arrangement of uncooked solid parts since Lamb teaches a brick shaped arrangement emerges from the apparatus as noted in Column 5, lines 8-17, 42-54 and shown in Figure 1 in light of Column 12, lines 50-62 .

### ***Conclusion***

35. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

36. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Madsen whose telephone number is (703)305-0068. The examiner can normally be reached on 7:00AM-3:30PM M-F.

38. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703)308-3959. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9310.

39. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at (703) 308-0061.

Robert Madsen  
Examiner  
Art Unit 1761



MILTON I. CANO  
SUPERVISORY PATENT EXAMINER  
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